

Appln. No. 09/965,723  
Amendment dated September 5, 2003  
Reply to Office Action mailed June 9, 2003

REMARKS

Reconsideration is respectfully requested.

Claim 7 remains in this application. Claims 1-6 have been cancelled.  
Claims 8-19 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 and 2 of the Office Action

The specification has been objected to for the informalities noted in the Office Action.

The specification has been amended in a manner believed to clarify any informalities in the language, particularly at the points identified in the Office Action.

Withdrawal of the objection is respectfully requested.

Paragraphs 3-5 of the Office Action

Claims 1 and 2 have been rejected under 35 U.S.C. §102(b) as being anticipated by Krusche (USPN D247075).

Claims 1 and 2 have been cancelled, as such the rejection under 35 U.S.C. §102(b) is mute.

Withdrawal of the §102(b) rejection of claims 1 and 2 is therefore respectfully requested.

Paragraphs 6 and 7 of the Office Action

Claims 1 and 2 have been rejected under 35 U.S.C. §102(b) as being anticipated by Fay (USPN 2674758).

Claims 1 and 2 have been cancelled. As such the rejection under 35 U.S.C. §102(b) is mute.

Withdrawal of the §102(b) rejection of claims 1 and 2 is therefore respectfully requested.

Appln. No. 09/965,723  
Amendment dated September 5, 2003  
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**Paragraphs 8 and 9 of the Office Action**

Claims 1 and 2 have been rejected under 35 U.S.C. §102(b) as being anticipated by Greenblatt (USPN 2958889).

Claims 1 and 2 have been cancelled. As such the rejection under 35 U.S.C. §102(b) is mute.

Withdrawal of the §102(b) rejection of claims 1 and 2 is therefore respectfully requested.

**Paragraphs 10 and 11 of the Office Action**

Claims 1 and 2 have been rejected under 35 U.S.C. §102(b) as being anticipated by Osiecki et al. (USPN 6499175).

Claims 1 and 2 have been cancelled. As such the rejection under 35 U.S.C. §102(b) is mute.

Withdrawal of the §102(b) rejection of claims 1 and 2 is therefore respectfully requested.

**Paragraphs 12 and 13 of the Office Action**

Claims 1 and 2 have been rejected under 35 U.S.C. §102(b) as being anticipated by Kilburn (USPN 5987687).

Claims 1 and 2 have been cancelled. As such the rejection under 35 U.S.C. §102(b) is mute.

Withdrawal of the §102(b) rejection of claims 1 and 2 is therefore respectfully requested.

**Paragraphs 14 and 15 of the Office Action**

Claims 1-4 and 6 have been rejected under 35 U.S.C. §102(b) as being anticipated by Van Staagen (USPN 6081958).

Claims 1-4 and 6 have been cancelled. As such the rejection under 35 U.S.C. §102(b) is mute.

Withdrawal of the §102(b) rejection of claims 1-4 and 6 is therefore

Appln. No. 09/965,723  
Amendment dated September 5, 2003  
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respectfully requested.

**Paragraphs 16 and 17 of the Office Action**

Claims 1-4 have been rejected under 35 U.S.C. §102(b) as being anticipated by Pearson (USPN 101307).

Claims 1-4 have been cancelled. As such the rejection under 35 U.S.C. §102(b) is mute. Withdrawal of the §102(b) rejection of claims 1-4 is therefore respectfully requested.

**Paragraphs 18-20 of the Office Action**

Claim 5 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Pearson in view of Bean (USPN 2988049).

Claim 5 has been cancelled. As such the rejection under 35 U.S.C. §103(a) is mute.

Withdrawal of the §103(a) rejection of claim 5 is therefore respectfully requested.

**Paragraphs 21 and 22 of the Office Action**

Claims 3-5 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Tyler in view of Bean (USPN 2988049).

Claims 3-5 have been cancelled. As such the rejection under 35 U.S.C. §103(a) is mute.

Withdrawal of the §103(a) rejection of claims 3-5 is therefore respectfully requested.

**Paragraphs 23 and 24 of the Office Action**

Claim 6 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Kilburn.

Claim 6 has been cancelled. As such the rejection under 35 U.S.C. §103(a) is mute.

Withdrawal of the §103(a) rejection of claim 6 is therefore

Appln. No. 09/965,723  
Amendment dated September 5, 2003  
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respectfully requested.

Paragraphs 25 and 26 of the Office Action

Claims 3-5 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Kilburn in view of Bean (USPN 2988049).

Claims 3-5 have been cancelled. As such the rejection under 35 U.S.C. §103(a) is mute.

Withdrawal of the §103(a) rejection of claims 3-5 is therefore respectfully requested.

Paragraphs 27 and 28 of the Office Action

Claims 3-5 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Kilburn in view of Bean (USPN 2988049).

Claims 3-5 have been cancelled. As such the rejection under 35 U.S.C. §103(a) is mute.

Withdrawal of the §103(a) rejection of claims 3-5 is therefore respectfully requested.

Paragraphs 29 and 30 of the Office Action

Claims 1-7 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Bean (USPN 2988049) in view of Kilburn.

Claims 1-6 have been cancelled. As such the rejection of claim 1-6 under 35 U.S.C. §103(a) is mute.

Regarding claim 7, specifically, it is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the

Appln. No. 09/965,723  
Amendment dated September 5, 2003  
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prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

The Bean reference teaches a grooming glove which conforms to both the shape of the hand of the user and the shape of the horse being groomed (Column 1 lines 45-48), while allowing the thumb and fingers to remain free to grasp to ropes, halters, or other items (column 1, lines 41-44). The office action proposes a combination of the brush of Bean with the gripping means of Kilbrun. However, the modification of the Bean brush would necessarily change the principle of operation of Bean by both limiting the freedom of the thumb and fingers to perform other tasks, and limit the conformability of the brush to the horse or other object being brushed.

However, this modification would change the principle of operation of Stewart. It is respectfully submitted that when the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

In re Ratti, 270 F2d 810, 123 USPQ 349 (CCPA 1959)

Withdrawal of the §103(a) rejection of claims 1-7 is therefore respectfully requested.

New claims 8 through 19 have been added to vary the scope of the claims and clarify the present invention. All limitations are supported by the original disclosure including the specification, drawings and original claims. Therefore, no new matter has been added. The new claims are believed to be allowable.

Appln. No. 09/965,723  
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**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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